

Application No. 10/716,535
Reply to Office Action of October 26, 2006

IN THE DRAWINGS

The attached sheet of drawings includes changes to Figure 1. This sheet, which includes Figure 1, replaces the original sheet including Figure 1.

Attachment: One Replacement Sheet

REMARKS/ARGUMENTS

Favorable consideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-32 are pending in the application. Claims 1, 12, and 32 are amended by the present amendment. As amended Claims 1, 12, and 32 are supported by the original disclosure,¹ no new matter is added.

In the outstanding Office Action, Claim 32 was objected to; the drawings were objected to; Claims 1, 4, 5, 12, 15, 16, 31, and 32 were rejected under 35 U.S.C. §103(a) as unpatentable over Clark et al. (U.S. Patent No. 6,784,869, hereinafter "Clark") in view of Briffe et al. (U.S. Patent No. 6,112,141, hereinafter "Briffe"); Claims 1-3, 7-9, 11-14, 18-20, and 22 were rejected under 35 U.S.C. §103(a) as unpatentable over Clark in view of Ebert et al. (U.S. Patent No. 5,931,874, hereinafter "Ebert"); Claims 6, 17, 26, and 30 were rejected under 35 U.S.C. §103(a) as unpatentable over Clark in view of Briffe and further in view of Yoshino et al. (U.S. Patent No. 5,548,304, hereinafter "Yoshino"); Claims 10 and 21 were rejected under 35 U.S.C. §103(a) as unpatentable over Clark in view of Ebert and further in view of Oder et al. (U.S. Patent No. 5,475,594, hereinafter "Oder"); and Claims 23 and 27 were rejected under 35 U.S.C. §103(a) as unpatentable over Clark in view of Ebert and further in view of Muller et al. (U.S. Patent No. 6,072,473, hereinafter "Muller").

With regard to the objection to Claim 32, Claim 32 is amended herewith to depend from Claim 12. Accordingly, the objection to Claim 32 is believed to be overcome.

With regard to the objection to the drawings, an amended Figure 1 is provided herewith including labels for the elements noted in the outstanding Office Action. Accordingly, the objection to the drawings is believed to be overcome.

¹See, e.g., the specification at page 11, lines 3-8 and Figure 5.

With regard to the rejections of Claim 1 as unpatentable over Clark in view of Briffe or Clark in view of Ebert, those rejections are respectfully traversed.

Claim 1 recites in part:

an auxiliary control device including a discrete moving mechanism configured to cause a discrete displacement of an auxiliary object marker on the display, responsive object by responsive object, so as to designate another responsive object ***on a same window*** without affecting control of the main object marker.

Clark describes a display management system including cursor control device (CCD) 212 that includes a touch screen 212d to move a *single* cursor on a display screen and switches 212a₁, 212a₂, and 212a₃ to move the *same* cursor from one display 201, 202', 204', 206', 208, and 209 to the next adjacent one of these displays.² Thus controls 212a₁, 212a₂, and 212a₃ ***do not move an auxiliary cursor discretely in the display from one responsive object to another responsive object on a same window.*** In fact, there is no teaching or suggestion in Clark that the movement of the same cursor from screen to screen is from one responsive object to another on the same window. Thus, Clark does not teach or suggest "an auxiliary control device" or "an auxiliary control marker" as recited in amended Claim 1. It is respectfully submitted that neither Briffe nor Ebert teach or suggest "an auxiliary control device" as recited in amended Claim 1 either.

Further, there is no suggestion or motivation to modify the device of Clark to create the claimed invention. Clark initially describes that the two described cursors ***cannot*** both be on a same screen,³ explicitly contrary to the invention recited in Claim 1 (hereinafter the first Clark embodiment). The outstanding Office Action noted that Clark does vaguely refer to allowing two cursors on one screen at the same time, but does not provide ***any*** information as

²See Clark, column 5, lines 57-60 and column 6, lines 20-28.

³See Clark, column 6, lines 46-48.

to how this would be accomplished⁴ (hereinafter the second Clark embodiment). Moreover, the outstanding Office Action cited the first Clark embodiment as describing the subject matter of Claim 31, after relying on the second Clark embodiment in the rejection Claim 1.⁵ This mixing of mutually exclusive embodiments clearly does not create a *prima facie* case of obviousness of Claim 31.

In addition, even if the second Clark embodiment is cited against Claim 1, there is no teaching or suggestion in Clark for moving a *second* cursor discretely with controls 212a₁, 212a₂, and 212a₃. In fact, if controls 212a₁, 212a₂, and 212a₃ did move a *second* cursor discretely, responsive object by responsive object, there would be no way to move the *first* cursor from display to display. Accordingly, the first cursor would be unsuitable for its intended purpose, which is to be available for use on all the screens of the display management system.⁶ Well settled case law holds that if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See also MPEP §2144.03. Thus, there is no suggestion or motivation to make the proposed modification to Clark.

The outstanding Office Action stated that the above-quoted case law is not pertinent to the present invention, as it is only relevant to chemical patent cases.⁷ However, the invention in *In re Gordon* was a mechanical invention, and further, it is respectfully submitted that the holding of this case is not in any way limited to any particular art area.⁸ If the assertion noted above is maintained, it is respectfully requested that the next office communication cite support for the conclusion that *In re Gordon* applies only to chemical inventions.

⁴See Clark, column 6, lines 53-55.

⁵See the outstanding Office Action at page 6, lines 5-16.

⁶See Clark, column 6, lines 40-42.

⁷See the outstanding Office Action at page 13, lines 8-13.

⁸See MPEP §2043.01(V).

In fact, the case law quoted in the outstanding Office Action regarding a reasonable expectation of success⁹ is irrelevant to the present question of whether there is a suggestion or motivation to combine the references as proposed in the outstanding Office Action.

Accordingly, as none of Clark, Briffe, or Ebert teach or suggest “an auxiliary control device” as recited in Claim 1, and there is no suggestion or motivation to modify Clark as proposed, Claim 1 (and Claims 2-11, 23-26, and 31 dependent therefrom) is patentable over Clark in view of Briffe and Clark in view of Ebert.

Claim 12 recites similar elements to Claim 1. Accordingly, Claim 12 (and Claims 13-22, 27-30, and 32 dependent therefrom) is patentable over Clark in view of Briffe and Clark in view of Ebert for at least the reasons described above with respect to Claim 1.

With regard to Claims 31 and 32, mutually exclusive embodiments of Clark are cited in the rejections of Claims 1 and 31, as noted above. Thus, it is respectfully submitted that a *prima facie* case of obviousness has not been provided for either of Claims 31 or 32.

With regard to the rejection of Claims 6, 17, 26, and 30 as unpatentable over Clark and Ebert in view of Yoshino, it is noted that Claims 6, 17, 26, and 30 are dependent from Claims 1 and 12, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Yoshino does not cure any of the above-noted deficiencies of Clark and Ebert. Accordingly, it is respectfully submitted that Claims 6, 17, 26, and 30 are patentable over Clark and Ebert in view of Yoshino.

Moreover, Claims 26 and 30 recite subject matter that further defines over Clark and Ebert in view of Yoshino. Claim 26 recites “the cursor control device and the auxiliary control device are configured so that *control* of the main object marker by the cursor control device has priority over *control* of the auxiliary object marker by the auxiliary control device

⁹See the outstanding Office Action at page 14, lines 1-8.

when both markers are on a same window.” (Claim 30 recites similar subject matter to Claim 26 in “means plus function” format.)

The outstanding Office conceded that Clark and Ebert do not teach or suggest the above-quoted element and cited Yoshino as describing this feature at column 12, lines 40-42.¹⁰ However, the cited portion of Yoshino only describes the determination of priority for selecting accessing and changing pages of information, *not priority of control of movement*. In fact, Yoshino does not teach or suggest that any of the described cursors has a priority of movement over any other, or affects the movement of any of the other cursors in any way (i.e. *all cursors can move independently*). Thus, Claims 26 and 30 recite subject matter that further defines over Clark and Ebert in view of Yoshino.

With regard to the rejection of Claims 10 and 21 as unpatentable over Clark and Ebert in view of Oder, it is noted that Claims 10 and 21 are dependent from Claims 1 and 12, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Oder does not cure any of the above-noted deficiencies of Clark and Ebert. Accordingly, it is respectfully submitted that Claims 10 and 21 are patentable over Clark and Ebert in view of Oder.

With regard to the rejection of Claims 23 and 27 as unpatentable over Clark and Ebert in view of Muller, it is noted that Claims 23 and 27 are dependent from Claims 1 and 12, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Muller does not cure any of the above-noted deficiencies of Clark and Ebert. Accordingly, it is respectfully submitted that Claims 23 and 27 are patentable over Clark and Ebert in view of Muller.

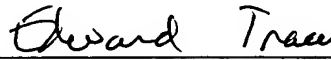
¹⁰See the outstanding Office Action at page 12, lines 7-12.

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Accordingly, in view of the present amendment and in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

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